

APR 07 2006

PATENT: OC01626K

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

K. Paruch et al.

Serial No.: 10/666,424

Filed: September 19, 2003

For: "Novel Imidazopyrazines as Cyclin  
Dependent Kinase Inhibitors"

Examiner: P. Ward

Group Art Unit: 1624

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE

Sir:

This communication is in response to the Official Action dated March 27, 2006, on the subject patent application. This communication is being faxed to the Examiner's attention at 571-273-8300.

Claims 1-15, 25 and 27 stand rejected under obviousness-type double patenting over pending, commonly-owned, application Serial No. 10/664,337. The Examiner rejected so, based on the response to restriction requirement that Applicants faxed on January 18, 2006. Upon review, Applicants now realize that the papers Applicants faxed on January 18, 2006 in the present case mistakenly got mixed up with the papers that Applicants faxed on the same date for the copending case 10/664,337. Applicants sincerely regret the unfortunate error and are now resending a proper, corrected, response to restriction requirement of December 27, 2005 in the present case.

(Incidentally, Applicants are sending out a correction in the case of 10/664,337 too.). Applicants respectfully request examination of the present case based on the presently submitted election and issuance of an Office Action.

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If the Examiner has any questions, the Examiner is invited to contact  
the undersigned.

April 7, 2006  
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Respectfully submitted,



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RESPONSE TO RESTRICTION REQUIREMENT AND ELECTION OF  
SPECIES

Sir:

This communication is in response to the Official Action dated December 27, 2005, on the subject patent application. This communication is being faxed to the Examiner's attention at 571-273-8300. A Fee Transmittal for one month extension is enclosed.

Claims 1-27 are pending in the case. The Examiner restricted the invention into four groups:

Group I: The compounds and compositions according to claim 1, Formula III, wherein R contains a heteroaryl/heterocycl moiety;

Group II: The compounds and compositions according to claim 1, Formula III, wherein R contains a non-heteroaryl/non-heterocycl moiety;

Group III: The method of treating according to claims 16-24, wherein R contains a heteroaryl/heterocycl moiety; and

Group IV: The method of treating according to claims 16-24, wherein R contains a non-heteroaryl/non-heterocycl moiety

If electing from among Groups I-IV, the Examiner additionally required the election of a single disclosed species for prosecution on the merits.

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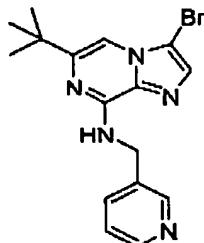
Applicants believe that all claims 1-27 form part of one and the same invention. Applicants further believe that when there is a linking claim (claim 1 here) encompassing the scope of all the processes, uses, composition and compounds, it is inappropriate to restrict the invention into these various inventions. Applicants also believe that due to such commonality, a complete examination of claims 1-27 as filed would not cause undue burden. Applicants further believe that the same art search will most probably apply to the alleged separate Inventions, and respectfully submit that the restriction is improper.

Under the statute "two or more independent and distinct inventions.... in one application may.... be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related.... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even when patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

In the present application, Applicant believes that the Examiner has not established a clear reason to establish the existence of any of the above 3 groups. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

However, in the interest of advancing the prosecution, Applicants elect, with traverse, the invention cited as Group II for prosecution on the merits, and elect the following species:



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again with traverse. This compound is shown as Compound No. 32 on page 31 of the specification, as well as in Claim 15.

If the Examiner has any questions, the Examiner is invited to contact the undersigned.

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